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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/845,953	04/30/2001	Terry Wayne Liles	16356.605 (DC-02889)	3329

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HAYNES AND BOONE, LLP
901 MAIN STREET, SUITE 3100
DALLAS, TX 75202

EXAMINER	
YIGDALL, MICHAEL J	
ART UNIT	PAPER NUMBER
2122	

DATE MAILED: 12/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/845,953	LILES ET AL.	
	Examiner	Art Unit	
	Michael J. Yigdall	2122	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *07 September 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-3,5-12,14-21 and 23-28* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-3,5-12,14-21 and 23-28* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. Applicant's amendment and response filed on September 7, 2004 has been fully considered. Claims 4, 13 and 22 have been canceled by Applicant's amendment. Claims 1-3, 5-12, 14-21 and 23-28 remain pending.

Response to Arguments

2. Applicant's arguments have been fully considered but they are not persuasive.

3. Applicant contends that the combination of Fontanesi and van Gilluwe does not teach identifying a sector offset on a storage device in response to a size of the storage device, and subsequently storing an image onto the storage device at the same sector offset that was identified in response to the size of the storage device (Applicant's remarks, page 10, last paragraph).

However, as noted in the previous Office action, Fontanesi discloses partitioning a storage device (column 6, lines 42-58), formatting the storage device (column 6, line 59 to column 7, line 4), and storing and installing an image file on the storage device (column 7, lines 5-25), among other operations. Inherently, Fontanesi must identify a location on the storage device with which to perform each of these operations. For example, Fontanesi cannot store an image file on the storage device, as disclosed, without first identifying a location at which to store the image file. Thus, Fontanesi teaches identifying a location on the storage device, and subsequently storing an image onto the storage device at the identified location.

Although the identified location on the storage device is not expressly a sector offset, van Gilluwe discloses identifying the number of sectors and the number and location of each

partition on a storage device (column 6, lines 17-34). The sectors are numbered based on a reference point (column 2, lines 12-15), which is to say that the sector numbers are offsets from the reference point. Van Gilluwe further discloses that the sector numbers, or in other words, the sector offsets, identify unique locations on the storage device (column 2, lines 15-25). Moreover, van Gilluwe expressly discloses determining the size of each partition and the amount of free space in each partition when identifying the location of a partition (column 6, lines 17-34). Thus, van Gilluwe teaches identifying a sector offset of a partition in response to a size of the storage device, such as the size of each partition.

Therefore, in combination, Fontanesi and van Gilluwe teach identifying a location on the storage device in terms of a sector offset, based on a size of the storage device, and storing an image onto the storage device at the identified sector offset. The image includes an operating system, as disclosed by Fontanesi (column 4, lines 1-23), and even as suggested by van Gilluwe (column 6, lines 35-49).

4. In response to Applicant's argument that there is no suggestion to combine the references (Applicant's remarks, page 13, second paragraph), the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In this case, Fontanesi and van Gilluwe are both directed toward the installation of an operating system (title and abstract of each). As discussed above, Fontanesi teaches storing an

image that includes an operating system on a storage device. The location at which to store the image must be identified. Van Gilluwe provides a means to identify that location based on the characteristics of the storage device. One of ordinary skill in the art would have been motivated to supplement Fontanesi with the teachings of van Gilluwe so that the location at which to store the image can be identified based on the characteristics of the storage device. Moreover, the combination is also desirable because, as disclosed by van Gilluwe, identifying the characteristics of the storage device enables one to determine whether it is even possible to install the operating system on the storage device (column 6, lines 35-49).

5. In response to Applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning (Applicant's remarks, page 14, first paragraph), it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. Claims 1-3, 5-12, 14-21 and 23-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Pat. No. 6,681,323 to Fontanesi et al. (art of record, "Fontanesi" herein) in view of U.S. Pat. No. 6,351,850 to van Gilluwe et al. (art of record, "van Gilluwe" herein).

With respect to claim 1 (currently amended), Fontanesi discloses a method performed by a computer system (see, for example, the title and abstract).

Although Fontanesi discloses determining the size of a storage device (see, for example, column 6, lines 51-55), Fontanesi does not expressly disclose:

(a) in response to a size of a storage device, identifying a sector offset on the storage device.

However, Fontanesi further discloses partitioning a storage device (see, for example, column 6, lines 42-58), formatting the storage device (see, for example, column 6, line 59 to column 7, line 4), and storing and installing an image file on the storage device (see, for example, column 7, lines 5-25), among other operations. Inherently, Fontanesi must identify a location on the storage device with which to perform each of these operations. For example, Fontanesi cannot store an image file on the storage device, as disclosed, without first identifying a location at which to store the image file. Thus, Fontanesi teaches identifying a location on the storage device.

Although the identified location on the storage device is not expressly a sector offset, van Gilluwe discloses identifying the number of sectors and the number and location of each partition on a storage device (see, for example, column 6, lines 17-34). The sectors are numbered based on a reference point (see, for example, column 2, lines 12-15), which is to say that the sector numbers are offsets from the reference point. Van Gilluwe further discloses that

the sector numbers, or in other words, the sector offsets, identify unique locations on the storage device (see, for example, column 2, lines 15-25). Moreover, van Gilluwe expressly discloses determining the size of each partition and the amount of free space in each partition when identifying the location of a partition (see, for example, column 6, lines 17-34). Thus, van Gilluwe teaches identifying a sector offset of a partition in response to a size of the storage device, such as the size of each partition.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to supplement the system of Fontanesi with the features taught by van Gilluwe so that the location at which to store an image file, for example, can be identified based on the characteristics of the storage device. Fontanesi and van Gilluwe are both directed toward the installation of an operating system (see, for example, the titles and abstracts). Accordingly, the combination of Fontanesi and van Gilluwe is also desirable because, as disclosed by van Gilluwe, identifying the characteristics of the storage device enables one to determine whether it is even possible to install the operating system on the storage device (see, for example, column 6, lines 35-49).

Therefore, Fontanesi in view of van Gilluwe teaches, in response to a size of a storage device, identifying a sector offset on the storage device.

Fontanesi in view of van Gilluwe further discloses:

(b) storing an image onto the storage device at the sector offset, the image including an operating system (see, for example, Fontanesi, column 7, lines 5-25, which shows transferring and storing an image file onto the storage device, and column 4, lines 1-23, which further shows that the image includes an operating system).

Note that as presented above, Fontanesi cannot store an image file on the storage device without first identifying a location at which to store the image file. Thus, Fontanesi teaches identifying a location on the storage device, and subsequently storing an image onto the storage device at the identified location. In view of van Gilluwe, the location is identified in terms of a sector offset.

(c) providing the sector offset to an installation engine (see, for example, Fontanesi, column 5, lines 25-38, which shows a boot storage medium for installing the operating system, i.e. an installation engine).

Again, the location on the storage device, identified in terms of a sector offset, is inherently provided to the installation engine so that it can operate.

(d) subsequent to storing the image on the storage device, initiating the installation engine to cause the operating system to be installed on the storage device using the image (see, for example, Fontanesi, column 7, lines 5-25, which shows installing and configuring the operating system from the image file subsequent to transferring and storing the image on the storage device).

With respect to claim 2 (original), Fontanesi in view of van Gilluwe further discloses, subsequent to initiating the installation engine, partitioning the storage device (see, for example, Fontanesi, column 5, lines 39-50, which shows initiating the installation engine, and column 6, lines 42-58, which shows subsequently partitioning the storage device).

With respect to claim 3 (original), Fontanesi in view of van Gilluwe further discloses, subsequent to initiating the installation engine, performing a formatting operation on the storage

device (see, for example, Fontanesi, column 5, lines 39-50, which shows initiating the installation engine, and column 6, line 59 to column 7, line 4, which shows subsequently formatting the storage device).

With respect to claim 5 (original), Fontanesi in view of van Gilluwe further discloses identifying the sector offset in response to a size of the image (see, for example, van Gilluwe, column 6, lines 35-49, which shows determining whether the operating system can be installed based on the size of the operating system).

With respect to claim 6 (original), Fontanesi in view of van Gilluwe further discloses providing the sector offset to the installation engine by storing the sector offset in a predetermined location on the storage device (see, for example, van Gilluwe, column 6, lines 17-34, which shows that the characteristics of the storage device are stored on the storage device, i.e. at a predetermined location, and Fontanesi, column 5, lines 53-61, which further shows storing a value at a predetermined location on the storage device).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the location or the sector offset to the installation engine by storing it in a predetermined location on the storage device, so that the sector offset can be maintained even in the event of a reboot (see, for example, Fontanesi, column 5, lines 53-61) or a power failure (see, for example, van Gilluwe, column 8, lines 21-32).

With respect to claim 7 (original), although Fontanesi discloses program logic, i.e. procedures and functions, for installing the operating system on the storage device (see, for example, column 5, lines 39-50), Fontanesi in view of van Gilluwe does not expressly disclose

providing the sector offset to the installation engine by passing the sector offset as part of a function call to initiate the installation engine.

However, passing a parameter as part of a function call is notoriously well known in the art. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the location or sector offset to the installation engine by passing it as part of a function call, as is known in the art.

With respect to claim 8 (original), Fontanesi in view of van Gilluwe further discloses storing the image onto the storage device by copying the image from a CD-ROM (see, for example, Fontanesi, column 7, line 66 to column 8, line 11, which shows transferring the image file from a CD-ROM).

With respect to claim 9 (original), Fontanesi in view of van Gilluwe further discloses storing the image onto the storage device by copying the image over a network (see, for example, Fontanesi, column 7, line 66 to column 8, line 11, which shows transferring the image file from a server over a LAN).

With respect to claims 10 (currently amended), 11-12 (original) and 15-18 (original), the recited computer program product is analogous to the method recited in claims 1-3 and 5-9, respectively. Accordingly, see Fontanesi and van Gilluwe as applied to claims 1-3 and 5-9 above, respectively. Note that Fontanesi further discloses a computer program product comprising a computer program processable by a computer system and an apparatus from which the computer program is accessible by the computer system (see, for example, column 5, lines 25-50 and column 8, lines 12-15).

With respect to claims 19 (currently amended), 20-21 (original) and 23-27 (original), the recited system is analogous to the method recited in claims 1-3 and 5-9, respectively. Accordingly, see Fontanesi and van Gilluwe as applied to claims 1-3 and 5-9 above, respectively. Note that Fontanesi further discloses a system comprising a computer system (see, for example, FIG. 1).

With respect to claim 28 (currently amended), the limitations of the recited method are analogous to the limitations of the method recited in claims 1, 3, 6 and 9. Accordingly, see Fontanesi and van Gilluwe as applied to claims 1, 3, 6 and 9 above.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael J. Yigdall whose telephone number is (571) 272-3707. The examiner can normally be reached on Monday through Friday from 7:30am to 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tuan Q. Dam can be reached on (571) 272-3695. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MY

Michael J. Yigdall
Examiner
Art Unit 2122

mjy

JOHN CHAVIS
PATENT EXAMINER
ART UNIT 2124